

Appln. No. 09/751,815
Amendment dated February 2, 2006
Docket No. 6988-1

REMARKS

This amendment is in response to the Office Action of August 2, 2005 (hereinafter Office Action). The amendment is submitted along with a request for a six-month retroactive extension and a Request for Continued Examination. Authorization is given to charge all appropriate fees to Deposit Account No. 50-0951.

Claims 1-5, 7, 14-18, and 20 were rejected in the Office Action under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,774,671 to Satoh (hereinafter Satoh) and U.S. Patent Number 5,675,637 to Szlam (hereinafter Szlam) in view of U.S. Patent Number 5,070,452 to Doyle (hereinafter Doyle). Claims 6 and 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Satoh and Szlam and further in view of U.S. Patent Number 6,349,299 to Spencer (hereinafter Spencer). Claim 8 was rejected under 35 U.S.C. 103(a) as being unpatentable over Satoh in view of Szlam and Spencer. Claims 9-13 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 4,876,643 to McNeil (hereinafter McNeil). Claim 21 was rejected under 35 U.S.C. 103(a) as being unpatentable over Satoh in view of Spencer, Szlam, and Doyle. Claims 22-28 and 30-36 were rejected under 35 U.S.C. 102(b) as being unpatentable over Doyle. Claim 29 was rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle and further in view of U.S. Patent Number 6,694,362 to Secor.

Subject Matter Under 35 U.S.C. 101

Claims 22-37 were also rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Specifically, it is stated at page 3 of the Office Action:

"Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 22-37 is deemed to be directed to non-statutory subject matter."

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With respect to Claims 30-37, Applicants note that the claims are directed to a machine-readable storage having stored thereon a computer program having a plurality of code sections that execute on a machine. Applicants respectfully assert, therefore, that each of the claims falls within a recognized "technological art," namely, that of computer-related technology.

More fundamentally with respect to Claims 22-37 generally, Applicants respectfully assert that it suffices under 35 U.S.C. 101 that, as noted in the Office Action, the claims are directed to an invention that "produces a useful, concrete, and tangible result." As recently stated by the Board of Patent Appeals and Interferences, "there is currently no judicially recognized separate 'technological arts' test," and the Board has declined "to create one." *Ex parte Lundgren*, 76 USPQ2d 1385, at 1388 (BPAI 2005). Nonetheless, Applicants have amended Claims 22-29 to expressly recite that the steps are implemented using computer-based technologies.

Applicants also have amended independent Claims 1, 8, 9, 14, 21, 22, and 30 to further emphasize certain aspects of the invention. Newly-presented dependent Claims 38 and 39 and independent Claim 40 have been presented to emphasize certain additional aspects of the invention. The claim amendments and newly-presented claims, as discussed herein, are supported throughout the Specification. (See, e.g., Specification, p. 14, lines 12-18; p. 15, lines 11-22; p. 16, line 14 - p. 17, line 21; p. 18, line 2 - p. 19, line 5; p. 27, lines 5-19; p. 28, lines 14-22; and p. 30, lines 1-19.) No new matter has been introduced by virtue of either the claim amendments or newly-presented claims.

Applicants' Invention

It may be useful to reiterate certain aspects of the invention prior to addressing the claim rejections and the cited references. One embodiment of Applicants' invention, typified by Claim 1, as amended, is a method for collecting consumer medical insurance information and providing the information to a medical service provider. The method

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can include transmitting, from a requesting medical service provider computer, a request for medical insurance information. The request can be received at a plurality of different network locations, each situated remotely from the other. The request can identify a consumer of medical services.

The method also can include retrieving from at least one of the plurality of different network locations the requested consumer medical insurance information corresponding to the identified consumer. The retrieving step, moreover, can include a search of eligibility information stored in databases at each of the plurality of different network locations in order to determine medical insurance coverage, with the retrieved consumer medical insurance information comprising at least medical insurance eligibility information relating to the consumer.

Additionally, the method can include verifying the identity of the consumer from at least one other network location. The method can further include transferring at least one data item in of the retrieved consumer medical insurance information to a corresponding field in a user interface of the requesting medical service provider computer.

The Claims, As Amended, Define Over The Cited References

Independent Claims 1 and 14, as already noted, were each rejected as unpatentable over Satoh and Szlam in view of Doyle. Applicants respectfully maintain that the references, alone and in combination, fail to teach or suggest every feature recited in Claims 1 and 14, as amended.

For example, as noted at page 7 of the Office Action, neither Satoh nor Szlam teach a data retrieval step that includes the searching of eligibility information for at least two insurance carriers to determine medical insurance coverage information pertaining to an identified consumer or the verifying of the identity of the consumer, as recited in

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independent Claims 1 and 14. It is stated in the Office Action, however, that these features are found in Doyle.

Doyle is directed to "an improved system for the administration of medical insurance claims." (Col. 1, lines 66-68.) Applicants respectfully assert, however, that the language of the reference reveals that Doyle is incapable of a retrieving step that includes searching a plurality of different network locations remote from one another and that Doyle, in fact, does not search eligibility information stored at multiple network sites to determine medical insurance coverage relating to a consumer, as recited in amended independent Claims 1 and 14.

Firstly, Doyle links a single data terminal 18 to a single, third party administrative computer 3. (See, e.g., Col. 2, lines 3-4; Col. 2, line 65 - Col. 3, line 5; and FIG. 1.) According to Doyle,

"[a]n administration computer 3 maintains a data base for each insurance plan provided by an employer. File 6 indicates the data base for plan ABC maintained by employer Alpha Company. The file includes a roster of all insured employees of Alpha Company, their spouses and dependents. In addition, the file includes a list of all medical treatments for which insurance compensation is available. (Each treatment is typically called a diagnosis, because the physician usually undertakes a diagnosis prior to embarking upon the treatment which the diagnosis indicates. An example would be a diagnosis of a sprained wrist in a patient Adam, followed by the treatment considered proper under the circumstances.) The file also contains a list of dollar amounts payable for each type of diagnosis. For example, in the file, X dollars is associated with the diagnosis for sprained wrist, meaning that insurance plan ABC will pay X dollars for the treatment of a sprained wrist." (Col. 2, lines 45-64.)

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Doyle's system explicitly does not determine whether said consumer has medical insurance coverage and, if so, which of a plurality of insurers provides the coverage. Instead, as explicitly described in Doyle, a patient who visits a physician needs to present an identification card. The identification in Doyle not only identifies the patient seeking treatment, but evidences that the patient is insured. (Col. 2, lines 65-68.) Thus, with Doyle, presentment of the identification card, not multiple database searching, is the mechanism for determining not only that the patient is insured but which insurer provides coverage.

The presentment of the card, alone, is the act that determines the specific insurance plan in which the patient is enrolled. The only function performed by a database search in Doyle is to confirm the determination already made. As explicitly described in Doyle,

"[w]hen a patient 9 visits a physician for treatment of [a] sprained wrist, the patient 9 presents an identification card 15 as evidence that the patient is covered by insurance plan ABC. The physician, using data terminal 18, communicates with the administration computer 3 on data link 21, and states to the computer the identity of the patient (Adam), the name of the patient's plan (ABC in this case) together with the diagnosis (sprained wrist). [The administration] computer 3 locates the file corresponding to plan ABC, confirms that the patient Adam is on the roster of insured persons, confirms whether the plan ABC will pay the physician for the given diagnosis (sprained wrist) and states the amount of reimbursement. In response, the physician can request the computer 3 to arrange a transfer of funds as payment." (Col. 2, line 65 – Col. 3, line 11.) (emphasis supplied.)

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Thus, the exact language of the reference explicitly states that, with Doyle, it is the physician, ostensibly by reading the card presented by the patient, who determines the patient's identify and the patient's plan, as well as a diagnosis of the patient's condition. When the physician communicates with the administrative computer 3 it is merely to "confirm" that the patient is on the roster of the of insured persons under the already-determined plan and to "confirm" whether the plan covers the diagnosis provided by the physician. This is completely counter to searching multiple databases at different, remote network locations to determine whether the patient is covered by insurance and, if so, which insurer provides coverage.

With Applicants' invention, a search of multiple, possibly unrelated, databases at a plurality of remote network locations determines whether the patient is insured and, if so, which insurer provides coverage. Doyle does not remotely suggest this feature. Nor can any such feature be legitimately inferred from Doyle since such a feature would render superfluous the patient's presentment of the "identification card" 15 which "evidences" that the patient is insured and "indicates" the specific "insurance plan" under which the patient is insured. (Col. 2, lines 65-68.)

Doyle's description of how a card can be "read" in order to "confirm" that the patient is covered merely underscores the differences between Doyle and Applicants' invention. The card is electronically read by a "Datatrol 8610" terminal, available from Datatrol Corp. (Col. 3, line 68 - Col. 4, line 5.) If the card is "not readable, then [a human] operator at the provider site types in the client's identification system, namely, his social security number (SSN), and a client code, which is a number identifying the ABC plan, from which insurance coverage is sought." (Col. 4, lines 5-10.) (emphasis supplied)

It must be noted that at this juncture in the Doyle procedure there has been no communication with even a single remote network location; the procedural steps have all

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occurred at the "provider site," with information being provided by an electronic reading of the identification card 15 or with a human operator manually entering the information into the system. Accordingly, it is impossible to infer that the identification of the insurer, which in Doyle is explicitly provided by the client code on the card, has been accomplished by a searching of multiple databases at different, remote network locations.

More fundamentally, Doyle provides no mechanism to determine whether or not a patient is even insured by one of several insurers by searching multiple databases. With Doyle, the contacting of a single network location merely confirms that a single, putative insurer indicated by the patient's card has the patient on its roster. At the point in Doyle's procedure when the single network location is communicated with, the putative insurer has already been determined. The remote network location contacted with Doyle merely confirms that the patient is insured under the plan indicated by the code on the card. But "confirming" is not determining, and with Doyle, what is confirmed is merely that the patient is in fact covered under the indicated plan and that the plan covers treatment for the condition diagnosed by the physician.

It is stated at page 17 of the Office Action that Doyle "teaches at Block 39 for insurance purposes different insurance coverage may be available for different reasons such as an automobile accident [that] may have caused the condition so that [an] automobile insurance company may have liability to the patient as opposed to Plan ABC." Applicants respectfully submit, however, that this has nothing to do with searching multiple databases at different network locations to determine whether the patient is in fact covered by one or more insurers and, if so, by which insurers. What Doyle in fact describes in connection with Block 39 is that the "reason for the visit to the physician" is important information for determining whether or not a proposed treatment is covered by the plan under which the patient has already been determined to be covered. The specific language of Doyle reads as follows:

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"Block 39 refers to statement of a reason for the visit to the physician selected from a table. One type of table includes four reasons, namely, the reasons of illness, prevention, maternity or accident. The reason for the visit can be important for insurance purposes because different insurance coverage may be available for different reasons motivating a visit. For example, plan ABC may provide maternity benefits for Adam's wife, but not his daughter. Further, some reasons, such as accident, can cause legal rights to arise for the benefit of in the plan, and so special procedures should be taken. For example, the YES (Y) path leading from block 42 indicates that an accident motivated the visit to the physician's office. Block 45 indicates that the computer terminal prompts the patient to complete a subrogation form which can give certain subrogation rights to the plan ABC. For example, an automobile accident may have caused the condition, so that an automobile insurance company may have a liability to the patient or to Plan ABC." (Col. 4, lines 21-40.)

The quoted portion in Doyle merely describes that once the patient's identity and condition are both determined, a collateral determination as to whether the plan covers treatment of the condition can be made. For example, as explicitly described by Doyle, it may be that if an employer's insurance plan covers both the employee's spouse and children, a spouse may be entitled to maternity treatment even if a daughter is not. Thus, with Doyle, coverage for maternity care depends on whether the card presenter is the wife or daughter of the covered employee. With Doyle, the card is presented at the provider site, and the physician, *after* determining both the relation of the presenter to the covered employee and treatment to be rendered, contacts the administrative computer to determine whether the treatment sought is covered. But this merely describes an example of how the patient's condition plays into the determination of whether a specific treatment

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is or is not covered under a specific plan that has already been determined to apply with respect to the patient presenting the card. It has nothing to do with an electronic search of eligibility information stored at each of a plurality of different network locations in order to determine whether a consumer has medical insurance coverage and, if so, with which insurer, as recited in amended independent Claims 1 and 14.

So, too, with respect to Doyle's recognition that a condition due to an automobile accident "can cause legal rights to arise [that necessitate taking] special procedures" like the patient's being required to complete a "subrogation form." Determining that a patient should, given the treatment sought, complete a subrogation form has nothing to do with searching multiple databases at different, remote network locations to make a determination about coverage under one or more different insurance plans. Specifically, recognizing the need to have the patient complete a subrogation form provides no hint as to whether the patient is alternatively covered under his or another's automobile accident insurance, let alone which automobile accident insurer is potentially liable; it merely suggests that there *may be* one – albeit unknown – and that, therefore, a completed subrogation form could have some *possible* future benefit. These features found in Doyle, however, have nothing to do with Applicants' invention.

Doyle, accordingly, fails to provide advantages afforded by Applicants' invention. With Applicants invention, a consumer seeking medical attention need not present a card. Indeed, the consumer need not even recall the specific insurer who provides coverage. All the consumer need provide at a provider site is identifying information by which an existing association between the consumer and the consumer's insurer can be determined by a search of multiple data sites located at remote network locations. The electronic searching, not the presentment of a card, determines whether the consumer is insured, and if so, by which insurer or insurers. If the consumer changes insurers, no new card need be issued in order for the consumer to assert coverage. A health care provider is advantaged by needing only the modicum of information needed to determine the

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existing association. The capability of searching of multiple information sites at a plurality of remote network location sites obviates the need to scan-in or type-in the various information that Doyle requires be obtained *before* a first connection with even a single information source is established.

Accordingly, the combination of Satoh, Szlam, and Doyle fails to teach or suggest every feature recited in independent Claims 1 and 14. Applicants respectfully submit, therefore, that each of independent Claims 1 and 14, as well as each claim dependent thereon defines over the prior art.

With respect to independent Claim 8, Applicants note, as above, that the claim was rejected as unpatentable over the combination of Satoh in view of Spencer and Szlam. Applicants, however, respectfully point out that the claim recites in steps (d) and (e) features acknowledged in the Office Action to be lacking in both Satoh and Szlam, though present in Doyle. Applicants respectfully assert that Spencer similarly fails to teach or suggest the recited features and that, for the reasons already presented, Doyle also fails to teach or suggest the recited features. Applicants respectfully maintain, therefore, that independent Claim 8, as amended, defines over the prior art.

Independent Claim 9, as also noted above, was rejected as unpatentable over McNeil. McNeil is directed to a "new and improved" system that effects, with parallel-processing techniques, the searching and updating of a database at the request of a host computer. (See, Col. 1, line 55 - Col. 2, line 31; see also Abstract.) Applicants respectfully assert, however, that McNeil is entirely silent as to at least some of the features recited in independent Claim 9. For example, McNeil neither teaches nor suggests any mechanism comparable to a consumer medical information matching system for retrieving said consumer medical insurance information, as recited in the claim. Specifically, McNeil does not teach or suggest a matching system that is capable of searching eligibility information stored at each of said plurality of different network

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locations and relating to at least two insurance carriers to determine medical insurance coverage in response to a request for medical insurance consumer information.

Accordingly, McNeil fails to teach or suggest every feature recited in independent Claim 9, as amended. Thus, Applicants respectfully assert that amended independent Claim 9 defines over the prior art. Applicants further respectfully assert that whereas dependent Claims 10-13 each depend from amended Claim 9 while reciting additional features, these claims likewise define over the prior art.

Independent Claim 21 was rejected as unpatentable over Satoh in view of Spencer, Szlam, and Doyle. At page 14 of the Office Action it is noted that Satoh, Spencer, and Szlam each fail to teach or suggest the search of eligibility information for at least two insurance carriers to determine medical insurance coverage. Doyle is again cited, however, as disclosing these features.

Claim 21 has been amended to recite the additional features described above. The claim, as amended, further recites receiving a request for consumer medical insurance information at a plurality of network locations located remotely from one another and identifying a consumer of medical goods and/or services. As amended, the claim additionally recites searching eligibility information stored at each of the plurality of different network locations – the information relating to at least two insurance carriers – to determine medical insurance coverage. For the reasons set forth above, Doyle does not teach or suggest the features recited in Claim 21 regarding medical insurance information. Accordingly, Applicants respectfully maintain that independent Claim 21, as amended, as well as each claim dependent thereon, defines over the prior art.

The remaining independent claim, Claim 30, was rejected as anticipated by Doyle. Claim 30 been amended to recite the additional features described in the context of the claims addressed above. For the reasons set forth, Applicants respectfully assert that Doyle fails to teach, expressly or inherently, each of the additional features and that

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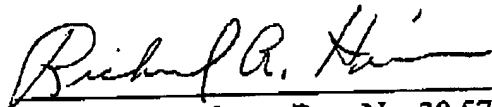
independent 30, as amended, as well as each claim dependent thereon, also defines over the prior art.

CONCLUSION

Applicants have made every effort to present claims which distinguish over the cited art, and it is believed that all claims are now in condition for allowance. However, the Examiner is invited to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. As already stated, the Commissioner for Patents is hereby authorized to charge the fee for a two month extension of time, as well as any other fees which may be due, to Deposit Account No. 50-0951.

Respectfully submitted,

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